

### **REMARKS**

Claims 1, 3, 5-23, 25-36, 38-46, 48-54, 56-71, 74-89, and 91-96 are now pending and stand rejected. By this Amendment, Applicant has amended claims 1, 15, 23, 35, 46, 53, 61, and 82 to further emphasize the distinctions from the prior art.

By this amendment, Applicant also demonstrates reasons why the claims pending here are distinct from the asserted art. In view of the above amendments to the claims and the legal reasoning shown below to demonstrate why the 35 U.S.C. § 103 rejections are improper, Applicant respectfully requests the Examiner to reconsider the outstanding rejections and to withdraw them.

#### ***Discussion of 112 Rejections***

Claims 1, 26, 53, 67, 81 and 86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In paragraph 5 of the office action, the Examiner indicates that he cannot find support for the limitation “automatically updating without any trigger by a user the list of supported formats to reflect the changes in applications included in the electronic device.” Respectfully, Applicant points the Examiner’s attention to paragraph 38 (see below) of the specification for support. The specification describes the concept of “automatically updating without any trigger by a user.” Also, paragraph 39 (see below) of the specification further emphasizes that the disclosure in paragraph 38 is expressly for the operation of “automatically updating” whereas the disclosure of paragraph 39 is with regard to “updates due to user triggered events.”

*“[0038] In an exemplary embodiment, list 150 may be updated prior to transmission to reflect the current state of applications 155 included in electronic device 100. Thus, in response to a request to receive electronic information 142, an application 155 in a web browser or elsewhere in electronic device 100 examines the applications included in electronic device 100 to determine every supported data format. List 150 may also be updated in response to changes in applications 155 as they occur. If an application 155 is added to or removed from electronic device 100, list 150 may be updated to include or exclude data*

*formats affected by the installation or removal. Additionally, if a file compatibility error has occurred, such that data formats normally supported by a particular application 155 may not be used by the application as currently configured, list 150 may also be updated to reflect that fact. File compatibility errors may occur when a portion of the application 155 has become corrupt or inoperable, such that certain data formats previously supported may not be utilized by the application 155. Viruses or changes to the operating system, among other things, may cause the file compatibility errors.*

*[0039] In a particular exemplary embodiment, while list 150 may be automatically updated as described above, a user may manually alter the contents of list 150 as well. In certain situations, a user may wish to prevent certain supported data formats from being transmitted to electronic device 100. For example, certain graphic or video files may be supported by applications in electronic device 100 but may be too large to transfer efficiently over a wireless connection. In another situation, the files may cause a drain in system resources (e.g., permanent memory space, random access memory, etc.). In these cases, the user may override the inclusion of particular data formats in list 150. A user may select an option to exclude all graphics or video formats, or may choose individual formats from a list of included formats. In the opposite situation, a user may wish to include unsupported data formats in list 150. For example, a user may wish to receive certain information 142 in electronic device and then transfer that information to another device having applications which support its particular data format. Here, the user would simply add the particular data format to list 150 despite the fact that application 155 included in electronic device 100 may not itself use information 142."*

## ***Discussion of 103 Rejections***

### ***1. Legal Construct Governing 35 U.S.C. § 103 Rejections***

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various

noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[R]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in KSR stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art **teaches away** from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

## 2. 35 U.S.C. § 103 Rejections

In paragraph 7, claims 1, 3, 5-19, 23, 25-27, 29-30, 32-33, 35, 38-39, 41-44, 46, 48-51, 53, 56-59, 67-69, 71, 74-75, 78-80, 86, 88-89, 91-92, and 93-94 are rejected under 35 U.S.C. Section 103(a) as unpatentable over Janakiraman et al., U.S. Patent Application Publication No. 2002/0124020, in view of Nelson et al., U.S. Patent No. 6,498,897 (hereafter Nelson) and further in view of U.S. Patent No. 6,877,037 to Adachi.

In paragraph 26, the Examiner rejected claims 20-22, 34, 45, 52, 60, 76-77 and 95-96 as unpatentable over Janakirama, Nelson, and Adachi as applied to claims 1, 23, 35, 46, 53, 67, and 86 above, and further in view of U.S. Patent No. 6,473,609 to Schwartz.

In paragraph 32 of the office action, the Examiner rejected claims 28, 31, 36, 54, 70 and 87 as unpatentable over Janakiraman, Nelson and Adachi as applied to claims 23, 53 and 86 above and further in view of Timothy et al., "Web Page Filtering and Re-Authoring for Mobile Users," (hereinafter Timothy).

In paragraph 35 of the office action, the Examiner rejected claims 61-62, 64-65 and 81-82 as unpatentable over Janakiraman in view of Castell (U.S. Patent Application Publication No. 2002/0132607).

In paragraph 40 of the office action, claims 63 and 83-84 are rejected under 35 U.S.C. Section 103(a) as unpatentable over both Janakiraman and Castell as applied to claims 61 and 81, and further in view of Adachi.

In paragraph 42 of the office action, claims 66 and 85 are rejected under 35 U.S.C. Section 103(a) as unpatentable over both Janakiraman and Castell as applied to claims 61 and 81 above, and further in view of Schwartz et al.

With respect to independent claims 1, 23, 35, 46, 53, 67 and 86, Applicant respectfully submits that the teaching in the Janakiraman patent and that in the present specification are different and that those differences are not obvious. Respectfully, Applicant directs the Examiner's attention to Figure 3 in the Janakiraman patent, which clearly shows that Janakiraman downloads an html file and then requests specific information. In the specific example described in the Janakiraman patent, Janakiraman's system looks for media files and selects which files to download.

Applicant's system and method clearly performs this task of restricting content differently. **Instead of selecting the files to download, Applicant's system has a server with a bandwidth limited connection, which downloads all data, then analyzes that data and finally selects data from the data downloaded, which meets specific criteria and sends it to the mobile device generally over a bandwidth limited connection. Applicant's system is analogous to a filter that can filter certain content over a connection. Paragraph 8 of the**

**present specification clearly indicates how Applicant's system can both work on media files and provide greater safeguard in comparison to the Janakiraman patent.**

In addition, the Examiner acknowledges that the Janakiraman patent does not disclose automatically updating the list of supported formats. Janakiraman is also silent on the teaching that the list of supported formats is sent to the proxy server upon selecting the electronic data. Therefore, even if the Janakiraman patent was combined with Nelson (which also does not disclose automatically updating the list of supported formats) and Adachi, the combination would fall short of the rejected claims here.

Janakiraman and Nelson are also silent on manually updating the list of supported formats and on sending a list of unacceptable source locations to a proxy server. Janakiraman is silent on the acceptability criteria that further comprises whether the electronic data has an acceptable source location. Janakiraman, Nelson and Adachi are silent on means for filtering the requested electronic data to exclude electronic data originating from an unacceptable source. Janakiraman is silent on the information transmission system comprising a proxy server configured to determine whether the requested electronic information has a supported format. Janakiraman is silent on information transmission system comprising a proxy server. A further combination with Schwartz or Timothy also falls short for the reasons by which Janakiraman by itself is distinct.

Respectfully, the Examiner is also urged to consider the legal construct for obviousness set forth above, which establishes the reasons that negate obviousness.

With respect to independent claims 61 and 81, and their dependents, the arguments urged above with respect to Janakiraman pertain. In addition, the Examiner cites the Castell publication. Respectfully, Applicant notes that the Castell publication has a filing date of March 8<sup>th</sup>, 2002, which is after the filing date of the present specification (July 26, 2001). The Castell publication does not meet the requirements of prior art.

Applicant respectfully submits that claims 3- 9, 25-34, 36- 45, 48-52, 54-60, 62-66, 68- 80, 82-85, 87-96 depend on claims 1, 23, 35, 46, 53, 61, 67, 81 and 86, respectively, and incorporate limitations not met by Janakiraman. Therefore, these dependent claims are also distinct for the same reasons by which the independent claims from which they depend are

distinct. Accordingly, the Examiner is urged to reconsider the rejections based on the arguments urged here.

***Conclusion***

Applicant respectfully requests the Examiner to reconsider the claims here either based on the amendments, arguments and the legal reasoning urged here. In the event there are outstanding issues, the Examiner is requested to call the undersigned to resolve them.

Respectfully submitted,

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